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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 75/446,316
Published in the Official Gazette on October 22, 2002



11-18-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

-----X

Elizabeth Arden, Inc.,

Opposer,

OPPOSITION NO.:

vs.

Ananda C. Rutkoff,

Applicant.

-----X

Box TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Elizabeth Arden, Inc., f/k/a French Fragrances, Inc., a corporation organized and existing under the laws of the State of Florida and the exclusive licensee by assignment of Avon Products, Inc., believes that it will be damaged by registration of the mark shown in Serial No. 75/446,316 in Class 3 (cosmetics and cleaning preparations) and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register THE MILLENNIUM HERO as a trademark for hygiene and beauty products, namely, skin soap, beauty masks, hair dyes and colorings, hair

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sculpting gels, hair lighteners, mascara, hair mousse, personal deodorants, hair shampoo, hair conditioner, hair spray, skin lotion, skin moisturizers, skin cleansing creams, skin creams, skin gels for accelerating tans, lipstick, eye shadow, blush and nail polish in International Class 3, claiming a bona fide intention to use the said THE MILLENNIUM HERO in commerce as evidenced by the publication of said mark in the Official Gazette on page TM 5 of the October 22, 2002 issue.

2. Opposer is the exclusive Licensee of Registrant (Avon Products, Inc.) and successor in title by assignment from Elizabeth Arden Co., a division of Conopco, Inc., a New York corporation ("Conopco").

3. On March 6, 1996, Registrant owner of the mark MILLENNIUM, Registration No. 1,166,901 (the "Mark") and Conopco entered into an exclusive license agreement (the "Agreement"), wherein Conopco was:

(a) granted an exclusive right and permission to manufacture, distribute and/or sell personal care products including skin treatment products and related goods in the United States under the Mark; and

(b) authorized to bring an action to protect the business of Conopco under the Mark with respect to unauthorized use or infringement. Opposer is submitting herewith as part hereof and marked Exhibit A, a copy of the Agreement.

4. Effective as of January 23, 2001, Conopco assigned the Agreement to Opposer.

5. Opposer and its predecessors in title have since June 27, 1979 used the Mark on a line of cosmetic creams for skin renewal. Opposer is submitting herewith as part hereof and marked Exhibit B, a copy of Registration No. 1, 166,901 issued September 1, 1981 covering the Mark.

6. There is no issue as to priority. The Applicant's filing date is subsequent to the issuance date of Opposer's Registration No. 1,166,901.

7. Opposer has sold its goods listed in the aforesaid registration under the Mark throughout the United States. Opposer has developed an exceedingly valuable goodwill in respect to the Mark covered by the registration.

8. By virtue of its efforts; and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its product, Opposer has gained for the Mark a most valuable reputation.

9. The trademark proposed for registration in Class 3 by the Applicant, namely, THE MILLENNIUM HERO incorporates in its entirety Opposer's Mark MILLENNIUM, and is with respect to its Class 3 items, applied to substantially similar and identical goods as those sold by Opposer and so nearly resembles the Mark as to be likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer's Mark so as to cause

confusion and lead to deception as to the origin of Applicant's goods bearing the Applicant's mark.

10. If the Applicant is permitted to use and register her mark for her goods, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's mark and the Opposer's Mark. Persons familiar with Opposer's Mark would be likely to buy Applicant's goods as and for a product made and sold by Opposer. Any such confusion in trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's products marketed under its mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its products and merchandise under its Mark.

11. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use its mark. Said registration would be a source of damage and injury to the Opposer.

WHEREFORE, the Opposer prays that the application Serial No. 75/446,316 be rejected and that the mark herein sought for the goods herein specified in International Class 3 be denied and refused.

A duplicate copy of this Notice of Opposition and the fee required in §2.6(a)(17) are enclosed herewith.

The undersigned Opposer hereby consents and appoints as its attorneys, Gary H. Fechter, a member of the Bar of the State of New York and William T. Heller, Robert W. Smith, Joan T. Pinari and David W. Opderbeck, as members of the Bar of the State of New Jersey, of the law firm of McCarter & English, LLP, 300 Park Avenue, 18th Floor, New York, New York 10022-7402, and whose telephone number is (212) 609-6800 as its duly authorized agents and attorneys in the matter of the opposition above-identified to prosecute said opposition to transact all business in the Patent and Trademark Office and in the United States Courts in connection with this Opposition, to sign their names to all papers which may hereinafter be filed in connection therewith, and to receive all communications relating to the same.

Dated: New York, New York
November 14, 2002

Respectfully Submitted,


ELIZABETH ARDEN, INC.

By 

Oscar E. Marina
Senior Vice President,
General Counsel and Secretary

STATE OF FLORIDA)
) SS.:
COUNTY OF MIAMI-DADE)

OSCAR E. MARINA, Senior Vice President, General Counsel and Secretary of Elizabeth Arden, Inc. being duly sworn, states that he has read and signed the Notice of Opposition herein and knows the contents thereof; and that the allegations are true, except as to the matters stated therein to be alleged upon information and belief, and as to those matters he believes them to be true.

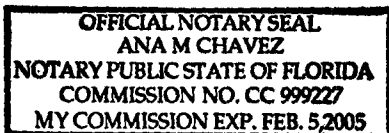

Oscar E. Marina

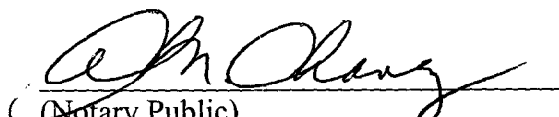
NOTARIAL CERTIFICATE

STATE OF FLORIDA)
) SS:
COUNTY OF MIAMI-DADE)

On this 14th day of November, 2002, before me, Ana M. Chavez, the undersigned Notary Public, personally appeared Oscar E. Marina, personally known to me to be the person whose name is subscribed to the within instrument, and acknowledged that he executed it.

(Notarial Seal)




(Notary Public)

AGREEMENT

This Agreement, effective as of the 6th day of March 1996, between AVON PRODUCTS, INC., a corporation having its address at 9 West 57th Street, New York, NY 10019 (hereinafter called LICENSOR) and ELIZABETH ARDEN CO., a division of Conopco, Inc., a corporation of the State of New York, with its address at 1345 Avenue of the Americas, New York, NY 10105 (hereinafter called LICENSEE).

WHEREAS, LICENSOR is owner of and has the right to use and license the trademark MILLENIUM in the United States ("the Territory") which is registered in the U.S. Patent and Trademark Office under No. 1,166,901, and has the right to use and license formatives and variations thereof; and

WHEREAS, LICENSEE is in the business of manufacturing, distributing and/or selling fragrance and personal care products, and desires to secure the license, right and permission to use the mark MILLENIUM in the Territory in connection with the manufacturing, distributing and/or selling of personal care products including skin treatment products and related goods (hereinafter "the Goods"), either by itself or through related or parent companies;

NOW, THEREFORE, in consideration of the promises and mutual covenants set forth herein it is hereby agreed:

1. LICENSOR hereby grants to LICENSEE an exclusive royalty free license, right and permission which shall be exclusive even as against Licensor, to manufacture, distribute and/or sell the Goods in the Territory bearing the mark MILLENIUM, either by LICENSEE itself or through related or parent companies. However, nothing stated herein shall in any way limit LICENSOR from making use of the trademark variation MILLENNIA on fragrance products and related goods.

2. The Goods bearing the mark MILLENIUM manufactured, distributed, and/or sold pursuant to this Agreement shall be of high quality, consistent with the quality of the ELIZABETH ARDEN MILLENIUM products existing as of the date of this Agreement.

Representative samples of said Goods of LICENSEE under this Agreement, together with samples of each of the packages in which the Goods are distributed or sold, shall be sent or furnished to LICENSOR, upon LICENSOR'S request.

3. This Agreement may be terminated by LICENSOR if LICENSEE is in breach of the terms of this Agreement and does not cure or begin to cure said breach within thirty (30) days following notice of breach by LICENSOR.

4. This Agreement shall continue without limitation, but shall automatically terminate upon any of the following events:

(A) LICENSEE'S or its successors in interest's failure to make use of the MILLENNIUM mark during any three-year period following execution of this Agreement, unless such period of non-use is excusable; LICENSOR'S or its successors in interest's failure to make use of the MILLENNIA mark during any three-year period, unless such use is excusable;

(B) The discontinuance of business operations by either party or by their successors in interest;

(C) The initiation of bankruptcy proceedings by or against either party or its successors in interest, which proceeding is not dismissed within ninety (90) days, or in the alternative, which does not result in a viable reorganization.

In the event this Agreement is terminated for any of the reasons set forth in said subsections (A), (B), or (C) as affecting LICENSOR, LICENSOR shall assign all rights in the MILLENNIUM and MILLENNIA trademarks to LICENSEE. LICENSOR appoints LICENSEE as its attorney-in-fact for the sole purpose of executing this assignment, in the event LICENSOR does not deliver an executed assignment within ten (10) business days of the occurrence of any of the aforesaid events.

5. LICENSEE acknowledges LICENSOR'S right, but not the obligation to take action, including the commencement of litigation, against any and all infringements of the marks MILLENNIUM or MILLENNIA or formatives and variations thereof. In the event LICENSOR does pursue said infringement(s) LICENSEE shall provide full cooperation to LICENSOR in its efforts against said infringement(s). In the case of a claimed infringement of the marks MILLENNIUM or MILLENNIA or formatives or variations thereof, should LICENSOR take no

action to stop such claimed infringement(s) within fifteen (15) business days following notice by LICENSEE of such infringement, then if LICENSEE in good faith believes that action is necessary in order to protect the business of LICENSEE or its related or parent companies, or action is necessary to protect the rights granted to LICENSEE hereunder, LICENSEE may itself bring an action with respect to such unauthorized use or infringement.

6. This agreement sets forth the entire Agreement between the parties, and supercedes any and all other agreements between the parties, whether written or oral, on the same subject matter. The terms hereof may not be changed or modified except by an instrument in writing duly signed on behalf of LICENSOR and LICENSEE.

IN WITNESS WHEREOF, the parties hereto caused this Agreement to be duly executed in their respective names as of the day and year first above written.

AVON PRODUCTS, INC.

By: *Walter A. Matus*
Title: *Vice President*

ELIZABETH ARDEN CO.

By: *M. C. Leonard*

Title: _____
Assistant Secretary.



Nº 1166901

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

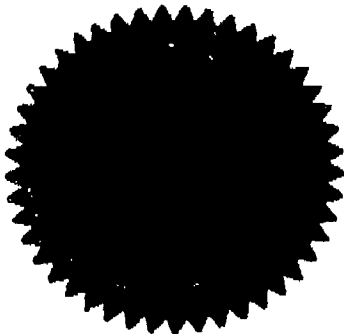
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this first day of September, 1981.

COMMISSIONER OF PATENTS AND TRADEMARKS



Int. Cl.: 3

Prior U.S. Cl.: 51

United States Patent and Trademark Office

Reg. No. 1,166,901

Registered Sep. 1, 1981

TRADEMARK

Principal Register

MILLENIU

Eli Lilly and Company (Indiana corporation)
307 E. McCarty St.
Indianapolis, Ind. 46206

For: COSMETIC CREAMS FOR SKIN RE-
NEWAL, in CLASS 3 (U.S. Cl. 51).

First use Jun. 27, 1979; in commerce Jun. 27, 1979.

Ser. No. 223,663, filed Jul. 16, 1979.

L. STRICKMAN, Primary Examiner

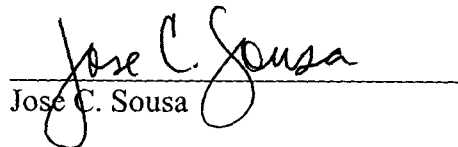
LISA N. KAUFMAN, Examiner

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" mailing label number: EV 115148853 US

Date of Deposit: November 18, 2002

I hereby certify that the original and one copy of the foregoing Notice of Opposition to Application Serial No. [75/446,316] is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under CFR 1.10 on the date indicated above, addressed to: Box TTAB – Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.


Jose C. Sousa

Date: November 18, 2002

MCCARTER & ENGLISH, LLP

ATTORNEYS AT LAW

300 PARK AVENUE

18TH FLOOR

NEW YORK, NEW YORK 10022-7402

(212) 609-6800

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11-18-2002

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #70

NEWARK, NJ

PHILADELPHIA, PA

WILMINGTON, DE

BOCA RATON, FL

CHERRY HILL, NJ

Direct Dial: (212) 609-6823

November 18, 2002

VIA US POSTAL SERVICE EXPRESS MAIL

Re: Opposition to Trademark Application for:
THE MILLENNIUM HERO
Serial No. 75/446,316

BOX TTAB - FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

Dear Sir or Madam:

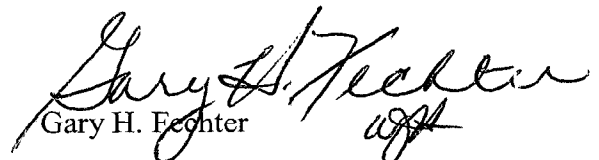
We enclose an original and two (2) copies of a Notice of Opposition and Certificate of Express Mailing on behalf of Opposer, Elizabeth Arden, Inc. for use in connection with opposition to the mark THE MILLENNIUM HERO trademark registration application.

Please charge our Deposit Account, No. 501402, the required \$300.00 filing fee and any additional fees which may be due in connection with this matter.

Kindly indicate receipt of this Notice of Opposition by stamping the enclosed postage-prepaid postcard, and returning it to us at your earliest convenience. Please direct all future correspondence to the address found above.

Thank you for your consideration.

Very truly yours,


Gary H. Fechter

Enclosures

cc: Oscar Molina, Esq.

NY1: 39639.01